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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,493	09/15/2003	Yuuichirou Tsuruta	0505-1245P	9236
2292	7590	11/13/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			EDWARDS, LOREN C	
PO BOX 747			ART UNIT	PAPER NUMBER
FALLS CHURCH, VA 22040-0747			3748	

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/661,493	TSURUTA, YUUICHIROU
	Examiner	Art Unit
	Loren C. Edwards	3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 September 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. Claim 16 recites the limitation "... wherein the upper plate and the lower plate are joined by the band member". There is insufficient antecedent basis for this limitation in the claim. The examiner believes this claim was intended to be dependent on claim 15, and for the sake of examination is interpreting as such.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 5-12, and 15-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hoeptner, III (U.S. 4,955,193). Hoeptner discloses a heat shield for a vehicle having an exhaust system member extending from an exhaust port of an internal combustion engine, the heat shield comprising: a first heat shield plate for surrounding a curved section of the exhaust system member (Fig. 2, No. 13; Fig. 1, No. 10b), the curved section being provided in the vicinity of the exhaust port; a second heat shield plate for covering above a straight section of the exhaust system member (Fig. 2, No. 13; Fig. 1, No. 10a), the straight section connecting to the curved section (Figs. 4a

and 4b); and a band member for supporting the first heat shield plate on the exhaust system member (Fig. 3, No. 26).

5. With regards to claim 2, Hoeptner discloses the heat shield of claim 1, as described above, and further wherein a small diameter section is provided on an end section of the first heat shield plate (Fig. 4a), and an end section of the second heat shield plate overlaps the small diameter section along a length of the exhaust system member, with a gap (Fig. 4b, I1 and I2) being provided in a radial direction between the small diameter section of the first heat shield plate and the end section of the second heat shield plate.

6. With regards to claim 5, Hoeptner discloses the heat shield for an internal combustion engine exhaust system of claim 1, as described above, and further wherein the first heat shield plate includes an upper plate and a lower plate (Fig. 3, No. 11). The examiner points out that the upper half of a section could be considered an upper plate, and the lower half a lower plate.

7. With regards to claim 6, Hoeptner discloses the heat shield for an internal combustion engine exhaust system of claim 5, as described above, and further wherein the upper plate and the lower plate are joined by the band member (Fig. 3, No. 26).

8. With regards to claim 7, Hoeptner discloses the heat shield for an internal combustion engine exhaust system of claim 1, as described above, and further wherein an end of the first heat shield plate adjacent to the exhaust port of the engine includes projection sections (Fig. 6a; No. 15), and the band member presses the projection

section against the exhaust system member to attach the first heat shield plate to the exhaust system member (Fig. 3).

9. With regards to claim 8, Hoeptner discloses the heat shield for an internal combustion engine exhaust system of claim 1, as described above, and further wherein an end section of the first heat shield plate away from the exhaust port is fixed tightly around the exhaust system member by the band member (Fig. 3), and an end section of the second heat shield plate extends forwardly over the band member (Figs. 4a and 4b), the end section of the second heat shield member being fixed to the exhaust system member by an attachment fixture (Fig. 3), the attachment fixture providing a space between the second heat shield plate and the exhaust system member through which air passes during travel (Fig. 4b).

10. With regards to claim 9, Hoeptner discloses the heat shield for an internal combustion engine exhaust system of claim 2, as described above, and further wherein the small diameter section of the first heat shield plate includes projections fitting into sections of the exhaust system member (Fig. 6a).

11. With regards to claim 10, Hoeptner discloses the heat shield for an internal combustion engine exhaust system of claim 1, as described above, and further wherein an intermediate portion of the first heat shield plate has a diameter larger than a diameter of an exhaust system member, and the band member wraps around the intermediate portion of the first heat shield plate (Figs. 4a and 4b).

12. With regards to claim 11, Hoeptner discloses a heat shield for an exhaust system member extending from an exhaust port of an internal combustion engine, comprising:

Art Unit: 3748

a first heat shield plate for surrounding substantially all of a curved section of the exhaust system member (Fig. 2, No. 13; Fig. 1, No. 10b), the curved section of the exhaust system member extending from the exhaust port; a second heat shield plate mounted over a straight section of the exhaust system member (Fig. 2, No. 13; Fig. 1, No. 10a), the straight section connecting to the curved section (Figs. 4a and 4b); and a band member (Fig. 3, No. 26) for supporting the first heat shield plate on the exhaust system member.

13. With regards to claim 12, Hoeptner discloses the heat shield of claim 11, as described above, and further wherein a small diameter section is provided on an end section of the first heat shield plate (Fig. 4a), and an end section of the second heat shield plate overlaps the small diameter section along a length of the exhaust system member, with a gap (Fig. 4b, I1 and I2) in a radial direction being provided between the small diameter section of the first heat shield plate and the end section of the second heat shield plate.

14. With regards to claim 15, Hoeptner discloses the heat shield of claim 11, as described above, and further wherein the first heat shield plate includes an upper plate and a lower plate (Fig. 3, No. 11). The examiner points out that the upper half of a section could be considered an upper plate, and the lower half a lower plate.

15. With regards to claim 16, Hoeptner discloses the heat shield of claim 15, as described above, and further wherein the upper plate and the lower plate are joined by the band member (Fig. 3, No. 26).

16. With regards to claim 17, Hoeptner discloses the heat shield of claim 11, as described above, and further wherein an end of the first heat shield plate adjacent to the exhaust port of the engine includes projection sections (Fig. 6a; No. 15), and the band member presses the projection sections against the exhaust system member to attach the first heat shield plate to the exhaust system member (Fig. 3).

17. With regards to claim 18, Hoeptner discloses the heat shield of claim 11, as described above, and further wherein an end section of the first heat shield plate away from the exhaust port is fixed tightly around the exhaust system member by the band member (Fig. 3), and an end section of the second heat shield plate extends forwardly over the band member (Figs. 4a and 4b), the end section of the second heat shield member being fixed to the exhaust system member by an attachment fixture (Fig. 3), the attachment fixture providing a space between the second heat shield plate and the exhaust system member through which air passes during travel (Fig. 4b).

18. With regards to claim 19, Hoeptner discloses the heat shield of claim 12, as described above, and further wherein the small diameter section of the first heat shield plate includes projections fitting into sections of the exhaust system member (Fig. 6a).

19. With regards to claim 20, Hoeptner discloses the heat shield of claim 11, as described above, and further wherein an intermediate portion of the first heat shield plate has a diameter larger than a diameter of an exhaust system member, and the band member wraps around the intermediate portion of the first heat shield plate (Figs. 4a and 4b).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

22. Claims 3, 4, 13, and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeptner in view of design choice. Hoeptner discloses the heat shield of claims 1 and 11, as described above, but fails to specifically describe wherein the exhaust system member is a U-shaped exhaust pipe which extends forwardly from the exhaust port of the engine, curves rearward, and extends in a substantially straight manner along one side of the engine to a position where the U-shaped exhaust pipe joins a middle pipe, or wherein the U-shaped pipe is formed as a one-part pipe. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use a one-part U-shaped exhaust pipe because Applicant has not disclosed that the shape of the exhaust pipe provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art,

furthermore, would have expected Hoeptner's exhaust pipe and applicant's invention, to perform equally well with the shape described in Figure 1 of Hoeptner or claims 3, 4, 13, and 14 because both shapes would perform the same function of routing exhaust gases from an engine considering their intended use. Therefore, it would have been *prima facie* obvious to modify Hoeptner to obtain the invention as specified in claims 3, 4, 13, and 14 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Hoeptner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Loren C. Edwards whose telephone number is (571) 272-2756. The examiner can normally be reached on M-TH 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Denion can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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